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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,411	02/01/2002	Edward G. Sutt JR.	P 278449 SFS-178REG1	9553
22204	7590	02/01/2006	EXAMINER	
NIXON PEABODY, LLP			BUI, LUAN KIM	
401 9TH STREET, NW			ART UNIT	PAPER NUMBER
SUITE 900				
WASHINGTON, DC 20004-2128			3728	

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/060,411	SUTT, EDWARD G.	
	Examiner	Art Unit	
	Luan K. Bui	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over

Shelton (4,836,372) in view of the Gabriel et al. (5,642,974; hereinafter Gabriel'974) or Oswald (6,905,525) and "Standard Specification for Driven Fasteners: Nails, Spikes, and Staples, American Society for Testing and Materials," (hereinafter ASTM). Shelton discloses a package (10) of collated nails comprising a plurality of nails (12) with each nail comprising a length including a substantially round head (14) having a head diameter, a flat top surface and a bottom surface, a single elongate shank (16) having a shank diameter, a point opposite the head and a plurality of surface deformations (50, 56) formed on the shank having a plurality of longitudinally spaced apart rings and at least one attachment element (32) constructed to temporarily attached the plurality of nails into a package. Shelton further discloses the nails may be siding nails, roofing nails, dry-wall nails, or other special-purpose nails. It is old and conventional that siding nails or dry-wall nails are made from steel wire. To the extent that Shelton fails to show each nail being made from steel wire, Gabriel'974 teaches a nail (20) for fastening a wooden board (10) may be made from plywood/sheathing comprising the nail is manufactured from 1030 carbon steel wire (column 3, lines 33-40). Oswald shows a nail-like device such as a drive pin (20) and the pin is made from a hardened steel such as C1060 steel and having a shank (28) with a shank diameter is in the range of 0.0625 to 0.125 inch. It would have

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been obvious to one having ordinary skill in the art in view of Gabriel'974 or Oswald to modify each nail of Shelton so each nail is manufactured from steel wire for better withstanding the forces imposed on the nail.

Shelton further fails to show the shank diameter between 0.092 to 0.148 inches, the length between 1.625 inches and 3.00 inches and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37. ASTM shows the nails in Table 36 comprising each nail having a length of 1.75 inches, a shank diameter of 0.113 inches and a head diameter of 0.312 inches. ASTM shows each nail having the ratio of the head diameter to the shank diameter is about 2.76. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of ASTM to modify the nails of Shelton so the shank diameter of each nail generally corresponds to a shank diameter as specified by ASTM F1667-95 comprises the shank diameter between 0.092 to .148 inches, the length between 1.625 inches and 3.00 inches and the ratio of the head diameter to shank diameter of each nail being between 2.70 and 3.37 to provide more standardize nail package and since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claims 3 and 4, it would have been obvious to one having ordinary skill in the art in view of Shelton as modified to increase the length of the nails to approximately 2 inches or 2.5 inches to provide more convenience for the user in a specific application and also for better securing the nails to the panel. Table 36 of ASTM shows the head diameter and the shank diameter remain unchanged when the length changes from 1.25 to 1.75 inches. With the head diameter and the

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shank diameter remain unchanged, the ratio of the head diameter to shank diameter is about 2.76 which is considered equivalent to “approximately 2.83” as claimed.

As to claims 8-10, Shelton discloses the attachment element comprises a pair of frangible tapes (30, 32, 62, 66) attached to each nail of the package. Shelton fails to show the attachment element comprises a frangible plastic binding element or a frangible wire welded to each nail. It would have been obvious to one having ordinary skill in the art in view of Shelton as modified to the modify the attachment element so the attachment element comprises a frangible plastic binding element or a frangible wire welded to each nail because the selection of the specific type of attachment element such as disclosed by Shelton or as claimed would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well and inasmuch as applicant's specification does not state that using these specific shapes as claimed solves any particular problem or yields any unexpected results.

As to claims 11, 16, 20 and 25, Shelton discloses the package of collated nails as modified as above having all the limitations of the claims except for the shank of each nail has a bending yield strength of greater than about 90 ksi. Oswald shows the shank diameter is in the range of 0.0625 to 0.125 inch (column 6, lines 20-24). According to page 10 of the specification of the instant Patent Application, it states “In accordance with NER-272 Section 3.3.2, the shank of the nails of the present invention preferably have a minimum average bending yield strength of 100 KSI (689 Mpa) for nails having a nominal diameter of 0.135 in or less.” Since Oswald shows the nails made from steel wire and having the shank diameter is in the range of 0.0625 to 0.125 inch.

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Therefore, each nail of Oswald would have a minimum average bending yield strength of 100 KSI (689 Mpa) in accordance with NER-272 Section 3.3.2. It would have been obvious to one having ordinary skill in the art in view of Oswald to modify the nails of Shelton as modified so each nail has the shank diameter is in the range of 0.0625 to 0.125 inch. and each nails has a minimum average bending yield strength of 100 KSI (689 Mpa) in accordance with NER-272 Section 3.3.2 to prevent the nail from bending when the forces imposed on the nail.

Response to Arguments

Applicant's arguments filed on 12/9/2005 have been fully considered but they are not deemed to be persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion and/or motivation can be found in the prior art references used in the rejection since the references are related to nails.

Applicant's arguments with respect to the table 36 of the ASTM F1667 are noted. They are not persuasive because the nails in the table 36 of the ASTM F1667 are capable to be used

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for attaching the sheathing to the structure and the table 36 of the ASTM F1667 was relied upon for nothing than the dimensions of the nails. Each of the nails of Shelton may be formed from steel or Oswald and Gabriel et al. discloses the nails are formed from steel.

Applicant's arguments with respect to claims 3, 4, 8 and 9 in the remarks are noted. They are not persuasive for the reasons as indicated above.

Applicant indicates that "the cited NER-272 reference does not disclose a steel nail suitable for sheathing" on page 10 of the amendments is noted. Applicant should amend the specification to indicate such statement.

Regarding the intended use of the claimed invention for sheathing, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb
January 27, 2006



Luan K. Bui
Primary Examiner
Art Unit 3728